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ROGITZ & ASSOCIATES			STRONCZER, RYAN S	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/802,589

Applicant(s)

HAWKINS ET AL.

Examiner

Ryan Stronczer

Art Unit

2425

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 16 October 2008 have been fully considered but they are not persuasive.

In response to the alleged "clear legal error" in the rejection of claim 1 set forth in the previous Office Action, the MPEP instructs that:

The focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and on what such a person would have reasonably expected to have been able to do in view of that knowledge. This is so regardless of whether the source of that knowledge and ability was documentary prior art, general knowledge in the art, or common sense. (MPEP § 2141, emphasis added)

Examiner maintains that the use of income in a personal profile as a basis for targeting or suggesting content would have been obvious to one of ordinary skill in the art at the time of the invention as a matter of both general skill in the art and common sense. Examiner further maintains that income is an obvious variant of the personal profile data taught by Fig. 2D of Hori, as cited in the previous Office Action.

As to Applicant's allegation that "age, sex, and marital status are personal characteristics; income is not" (Remarks, pg. 3), Examiner notes that the features upon which applicant relies are not recited in the rejected claim(s). The claim language does not recite "personal characteristics," as alleged, but merely "data selected from the group including demographic data representative of income range" and Examiner further notes that income and marital status are both commonly queried demographic data. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. As there is no reason supported by common

sense or general knowledge in the art at the time of the invention that income would not be an obvious variant of the demographic data recited in claim 1, the rejection of claim 1 set forth in the previous Office Action is maintained.

With respect to claim 5, Applicant alleges that "the examiner is completely unable to point to *evidence of record* of a teaching to bill for a download using purchase price information in metadata" (Remarks, pg. 3). Examiner disagrees. Paragraph 0017 of Pontenzone, as cited in the previous Office Action, teaches that the metadata associated with a specific piece of content contains billing information. Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention for the billing information in the metadata associated with a specific piece of content to contain purchase price.

As to Applicant's continued insistence that the metadata is used for billing in a manner divergent from that taught by Pontenzone, Examiner disagrees. The specific use of the metadata recited in claim 5 is to indicate a billable event, which use is consistent with Applicant's admitted potential use of the billing information taught by Pontenzone of "alert[ing] the user how much a subsequent purchase might cost" (Remarks, pg. 4). For at least these reasons, the rejection of claim 5 set forth in the previous Office Action is maintained.

Applicant's arguments, see page 2, filed 16 October 2008, with respect to the rejection(s) of claim(s) 8-15 under Goronzy have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Holtz.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone et al. (Pub. No. US2002/0152278) and further in view of Hori et al. (US Pat. No.: 7,209,942).

Claim 1 is rejected for the same reasons as set forth in the previous Office Action. As to the amended limitation that the database contain demographic data including, "income range," Pontenzone, as applied in the previous Office Actions, teaches the recited system but does not explicitly teach the recited demographic data. Hori et al. teaches a method for a search engine to suggest content to a user. Fig. 2D teaches that the system considers the user profile when searching the database, said profile including information including: sex, age, marital status, etc. Though not explicitly taught by Fig. 2D, income range is an extension of the personal profile taught by Hori that would have been obvious to one of ordinary skill in the art at the time of the invention as it would have allowed the system to present the user with more personalized search results. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the system taught by Pontenzone with the

user profile and preferences taught by Hori to provide users with content that they are more likely to wish to purchase.

As to claim 2, the system taught by Pontenzone is intended to be used by any user with Internet access and a web-browser, thus the functionality of claims 2 and 4 are inherent in the system taught by Pontenzone.

Claim 4 recites the system of claim 1, wherein "the playlist is stored on the network, such that its consumer can share the playlist with other users on the network." Fig. 1 of Pontenzone teaches a system comprising a database **400** and a station and playlist management module **235** which are accessible to a user through front end **300**. Pontenzone further teaches that the station and playlist module *"manages the content delivered by a number of stations over the network"* [ABST]. In light of system 100 and the fact that the content streamed over the network by Pontenzone is intended to be shared with users via the Internet, the recited functionality is inherent in the system of Pontenzone.

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone et al. as applied to claim 1 above, and further in view of Asmussen et al. (Pub. No.: US2002/0042923) and Hempleman et al. (US Patent No.: 6,243,725).

The rejection of claim 5 set forth in the previous Office Action is incorporated herein. As to the amended limitation that "...if the metadata associated with the title indicates a billable event, at least in part using purchase price information in the metadata, billing the user for downloading content associated with the title," Pontenzone

does not explicitly teach that the user can purchase a specific title from a playlist, as claimed. Asmussen teaches a multimedia content suggestion engine, similar to the search engine taught by Pontenzone in which metadata content associated with a specific multimedia file may contain, "...a program description, including program rating, program description, video clips, program length, format (e.g., 4.times.3 television or 16.times.9 movies), and other information; billing information and digital rights management information" [0017]. It would have been obvious to one of ordinary skill in the art at the time of the invention that the billing information contained in the metadata file taught by Asmussen could be purchase price information, as recited.

As to claim 6, Fig. 6-7 of Hempleman teach methods for accepting payment from a user. Regarding keeping records of transactions, Hempleman teaches, "[r]eport information can be transmitted to the system **20** for billing purposes...as well as making royalty payments to appropriate recipients" (Col. 7, Line 34-39). The system (object **20**) is located remotely from the user and is connected to the terminal via an Internet connection, as shown in Fig. 6-7. As analyzed above the combination of Hempleman with Pontenzone would have been obvious to one of ordinary skill in the art at the time of the invention.

As to claim 7, Asmussen teaches a system which allows a user to search for multimedia content on a digital communication network and which tracks user data. Asmussen teaches, "[a] user database server **511** maintains an aggregator user database **512**, which stores and processes information including, but not limited to, user account data, user profile information, user subscription services, user access rights,

and past user search and download data (if authorized by the user)" [0072]. It would have been obvious to one skilled in the art at the time of the invention to incorporate the user database server taught by Asmussen into the system taught by Pontenzone to provide better users of Pontenzone's system with increased access to available content.

Claims 8-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone as applied to claim 1 above, and further in view of Asmussen and Holtz et al. (Pub. No.: US 2002/0053078).

As to claim 8, Pontenzone teaches a method for generating a multimedia playlist based on a user search and allows users to create user profiles or identities that are stored on the network, but does not explicitly teach methods for archiving user search history or for using such archives to generate search results. Asmussen teaches an analogous method for searching content on a digital communications network, including functionality to store user profile information comprising:

user account type, user access level, and historical data. The user history analysis report is a summary of statistical analysis of the user's previous account activities that may include previous search requests, returned search results, and content download requests. [0078]

As to generating content suggestions based on the user profile data, paragraphs 0086 and 0116-117 of Holtz teach a system for generating content suggestions based on user profile data. Specifically, paragraph 0086 of Holtz teaches:

Each time enhanced media server 115 is accessed, data is captured and stored to develop a profile of the user. Every time the same enhanced media client 120 logs onto enhanced media server 115, enhanced media client 120 receives a customized preprogrammed show according to the user's profile.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the playlist generation system of Pontenzone with the user profile taught by Asmussen and the search method taught by Holtz to allow the system to present users with profile-specific content suggestions in a manner cumulative the claimed method.

Claim 9 recites the method of claim 8, "...without constraining the client device to be a particular single type of device." The playlist taught by Pontenzone is intended to be distributed to users via Internet radio. It is inherent that the playlist taught by Pontenzone can be accessed by users via more than one specific client device.

As to claim 10, both Pontenzone and Asmussen teach functionality for users to initiate a search.

As to claims 11 and 12, the recited functionality is inherent in the system taught by Pontenzone. Fig .1 of Pontenzone teaches a system comprising a database **400** and a station and playlist management module **235** which are accessible to a user through front end **300**. Pontenzone further teaches that the station and playlist module *"manages the content delivered by a number of stations over the network"* [ABST]. In light of system 100 and the fact that the content streamed over the network by Pontenzone is intended to be shared with users via the Internet, the recited functionality is inherent in the system of Pontenzone.

As to claim 15 Asmussen teaches that the system is capable of receiving a search request from a user and in paragraph 0078 (cited above) teaches that the system further stores past search requests.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pontenzone in view of Asmusen and Holtz as applied to claim 8 above, and further in view of Hempleman.

As to claim 13, Pontenzone in view of Asmusen and Holtz teaches the method of claim 8, but does not explicitly teach that the user can purchase a specific title from the playlist as claimed. Asmusen teaches that a specific multimedia file may contain, *"...a program description, including program rating...billing information and digital rights management information"* [0017] but does not explicitly teach a mechanism for utilizing the billing data to purchase the specified content. Hempleman teaches an analogous system for creating a playlist via a user-initiated search request, similar to that taught by Pontenzone. Fig. 6 of Hempleman teaches a "credit card input device" that facilitates the purchase of multimedia content over a network. *"The unit 20 also supervisory and billing services in response to requests by the end user's unit 22 for access to one or more of the works stored in the inventory in the databases 20b"* (Col. 6, Lines 55-60). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the purchasing functionality taught by Hempleman with the content request functionality taught by Pontenzone to facilitate the purchase of requested content.

As to claim 14, Fig. 6-7 of Hempleman teach methods for accepting payment from a user. Regarding keeping records of transactions, Hempleman teaches that *"[r]eport information can be transmitted to the system 20 for billing purposes...as well as making royalty payments to appropriate recipients"* (Col. 7, Line 34-39). The system

(object **20**) is located remotely from the user and is connected to the terminal via an Internet connection, as shown in Fig. 6-7.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Stronczer whose telephone number is (571) 270-3756. The examiner can normally be reached on 7:30 AM - 5:00 PM (EDT), Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian T. Pendleton can be reached on (571) 272-7527. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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